

REMARKS

Claims 6-13 and 17-25 have been examined, and have been rejected under 35 U.S.C. § 112, second paragraph, and under 35 U.S.C. § 103(a). The Examiner continues to reject the claims in view of the APA and Ota.

I. Rejections under 35 U.S.C. § 112, second paragraph

The Examiner has rejected claims 6-13 and 17-25 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. The Examiner again maintains that the metes and bounds of the claims are not clear since it is unclear if a single cassette or a collection of cassettes is claimed.

The claims were discussed during the November 17, 2004 Examiner Interview with the Examiner and the Examiner's Supervisor. The Examiner's Supervisor indicated that the body of the claims need to actually refer to the positioning pins of the recording and reproducing apparatus to tie the recording and reproducing apparatus of the preamble into the body of the claims. Accordingly, the claims have been amended in accordance with the discussions of the November 17, 2004 Examiner Interview.

Further, for the reasons set forth in the December 17, 2003 Amendment, Applicant submits that the claims are *not* indefinite. All tapes are recited in cooperation with a single recording and reproducing apparatus. Also, the fact that a claim is broad does not necessitate a rejection for indefiniteness reasons. In non-chemical arts, a claim may generally be written as

Amendment under 37 C.F.R. § 1.114(c)
U.S. Application No. 10/088,230

broadly as permitted by the prior art. Applicant refers the Examiner to U.S. Patent No. 4,158,871 to Leaming, for an example of a “kit” type claim.

In view of the above, Applicant respectfully requests the Examiner to reconsider and withdraw the rejection under 35 U.S.C. § 112, second paragraph.

II. Rejections under 35 U.S.C. § 103(a) in view of the admitted prior art (“APA) of pg. 1, line 7 to pg. 7, line 19 and Figs. 10-12 of the present Application

The Examiner has rejected claims 6, 9, 17 and 20 as being unpatentable over the APA.

A. Claim 6

Applicant submits that claim 6 is patentable over the APA. For example, claim 6 recites that a difference between a height of the radially inner portion and a height of the ribs is the same for each of the varying size magnetic tape cassettes.

The Examiner acknowledges that the APA does not disclose the above feature, but contends that it would have been obvious to modify the APA to arrive at the claimed invention. In particular, on pg. 6 of the Office Action, the Examiner maintains that it would have been obvious to one having ordinary skill in the art that the same clearance would have been acceptable on cassettes having other sizes. However, as clearly taught by the APA, the clearance of the varying size cassettes are positioned differently. For example, in order to avoid hinderance of the rotation of the tape reels, the APA discloses a method where the lower and upper flanges of the LL cassette are positioned differently than the S and L cassette (pgs. 5 and 6

of the Office Action). Based on such disclosure, one skilled in the art would not be motivated to have all the clearances the same in every cassette.

As set forth in MPEP §2143.01, the mere fact that a reference can be modified does not render the modification obvious unless the prior art also suggests the desirability of the modification. Since the APA specifically teaches that the clearances should be “different” to avoid the disclosed problems, Applicant submits that the APA fails to *suggest* that the clearances should be the same. Rather, the APA appears to teach away from having the clearances of every size cassette to be the same.

After discussing the method of the APA in the present Application, the Applicant discusses problems with the APA and concludes that the different clearances will cause, for example, the tape to be slackened and possibly damaged in the larger cassettes (pg. 6 of Application).

Further, the Examiner maintains that selection of cartridge dimensions would have been well within the level of skill of an ordinary artisan. However, as set forth in MPEP §2143.01, the level of skill in the art cannot be relied upon to provide the suggestion to combine or modify references. As set forth above, the only suggestion provided by the APA is to have the clearances be different. There is no teaching in the APA of having the difference between a height of the radially inner portion and a height of the ribs to be the same for each of the varying size magnetic tape cassettes.

In view of the above, Applicant submits that the Examiner has not established a prima facie case of obviousness, and accordingly, requests the Examiner to cite a reference in support of his position.

B. Claim 9

Since claim 9 is dependent upon claim 6, Applicant submits that claim 9 is patentable at least by virtue of its dependency.

C. Claim 17

Since claim 17 contains features that are analogous to the features recited in claim 6, Applicant submits that claim 17 is patentable for at least analogous reasons as claim 6.

D. Claim 20

Since claim 20 is dependent upon claim 17, Applicant submits that that 20 is patentable at least by virtue of its dependency.

III. Rejections under 35 U.S.C. § 103(a) in view of the APA and JP 5-347079 to Ota et al. (“Ota”)

The Examiner has rejected claims 7, 8, 10-13, 18, 19 and 21-25 under 35 U.S.C. § 103(a) as being unpatentable over the APA and Ota.

A. Claim 7

Applicant submits that claim 7 is patentable over the cited references. For example, claim 7 recites that inclinations defined by tape running paths are the same for each of the varying size magnetic tape cassettes.

The Examiner acknowledges that the APA does not disclose the above feature, but contends that Ota does. In particular, the Examiner maintains that Ota discloses cassettes of different sizes that have “similar” tape inclinations (i.e. not the “same”), but that it would have been obvious to form cassettes with the recited relative dimensions (pg. 7 of Office Action). However, the somewhat “similar” tape inclinations of Ota are no closer to suggesting the claimed “same” inclinations as Figs. 12(a) and 12(b) of the APA are. In other words, the figures of Ota and the APA show varying tape inclinations, but none shows or suggests that the inclinations are the *same* for each cassette. Therefore, the Examiner has combined two references, neither of which disclose the claimed recitation, and maintains that it would have been “obvious” to arrive at the claimed invention since the range of usable dimensions for forming cassettes is well known in the art. However, similar to Applicant’s comments regarding claim 6, absent a suggestion, the mere fact that a reference can be modified does not render the modification obvious (MPEP §2143.01).

Applicant respectfully requests the Examiner to indicate where Ota specifically provides a suggestion for modifying Ota in the claimed manner, or to cite an additional reference in support of his position, if the rejection is to be maintained.

B. Claim 8

Since claim 8 contains features that are analogous to the features recited in claim 7, Applicant submits that claim 8 is patentable for at least analogous reasons as set forth for claim 7.

In addition, regarding the claimed widths of the tape running openings, Applicant respectfully requests the Examiner to cite a reference in support of his conclusion that the recitation is obvious.

C. Claims 10 and 11

Since claims 10 and 11 are dependent upon claims 7 and 8, respectively, Applicant submits that such claims are patentable at least by virtue of their dependency.

D. Claims 12, 18 and 23

Since claims 12, 18 and 23 contain features that are analogous to the features recited in claim 7, Applicant submits that claims 12, 18 and 23 are patentable for at least analogous reasons as presented above.

E. Claims 13, 19, 24 and 25

Since claims 13, 19, 24 and 25 contain features that are analogous to the features recited in claims 7 and 8, Applicant submits that claims 13, 19, 24 and 25 are patentable for at least analogous reasons as claims 7 and 8.

F. Claims 21 and 22

Since claims 21 and 22 are dependent upon claims 18 and 19, respectively, Applicant submits that such claims are patentable at least by virtue of their dependency.

Conclusion

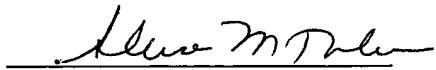
In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any

Amendment under 37 C.F.R. § 1.114(c)
U.S. Application No. 10/088,230

overpayments to said Deposit Account.

Respectfully submitted,



Allison M. Tulino
Registration No. 48,294

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: January 5, 2005